



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,415	10/17/2003	Naozumi Sugimura	16869P-095000US	2204

20350 7590 04/04/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
----------	--------------

2161

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,415

Applicant(s)

SUGIMURA ET AL.

Examiner

Susan Y. Chen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/17/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-10 are pending for examination.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Objections

Claims 1-2 and 5-6, are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 3-4, 7-8 and 9-10. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight

difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Noguchi et al. (U.S. Patent No. 6,813,434; hereinafter referred as Noguchi) in view of SeKiguchi et al. (U.S. Publication No. 2001/0004739; hereinafter referred as SeKiguchi).

Claims 3, 7 and 9:

Noguchi discloses a recording medium used for recording and reproducing data from a recording medium, comprising:

an optical pickup for radiating a light ray to said recording medium [e.g., the pickup unit 2, Fig. 1 and associated texts]; and

a control microcomputer [e.g., the CPU 17, Fig. 1 and associated texts] for controlling said reproducing apparatus, wherein said control microcomputer controls an

operation to reproduce a first program list [e.g., the first play lists of Fig. 7] prescribing an order to reproduce data; or

a second program list [e.g., the second play list of Fig. 9A and associated texts] prescribing the same order to reproduce data as said first program list by using said optical pickup from said recording medium used for recording said first and second program lists [e.g., the Information Reproduction Using play List section, starting at col. 13, lines 37 at seq.].

Noguchi did not expressly disclose that the second program list has different format from the first program list.

However, SeKiguchi expressly discloses an image recording and reproducing apparatus, wherein, the second program list has different format from the first program list and the benefit of using different formats [e.g., P1, section: 0003; P4, sections: 0048-0051; P. 6, sections: 0083-0092].

Noguchi and Sekiguchi are both in the same field of endeavor to facilitate images recording and reproduce via user interface, thus, with the teachings of Noguchi and SeKiguchi in front of him/her, it would have been obvious for an ordinary skilled person in the art at the time the invention was made to be motivated to modify Noguchi's invention by using a second program list having different format from the first program list as taught by SeKiguchi, because by doing so, as suggested by Sekiguchi the combined apparatus would have been upgraded to facilitate users interact with different databases stored in various network addresses with just one Universal Resource Locator (URL) to efficiently locate different formatted images distributed in Internet for

Art Unit: 2161

recording and reproducing data as they desired [e.g., Sekiguchi: P.4, sections: 0048-0051; P.6, section: 0092].

Claims 4, 8 and 10:

Except the features of claims 3, 7 and 9, the combined apparatus of Noguchi and SeKiguchi further discloses first program list is a list written in a text format [e.g., SeKiguchi: P. 6, section 0088] and said second program list is a list written in a non-text format [e.g., SeKiguchi: P. 6, section 0091].

As to claims 1-2 and 5-6, these claims recite the same features as claims 3-4, 7-8 and 9-10, except in broader scope by using different words, hence, they are rejected for the same reason.

Conclusion

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Call (U.S. Patent No. 6,154,738) which discloses a system disseminating product information via Internet using Universal Product Code.

Numata (U.S. Publication No. 2001/0014966) which discloses a program development method for processing storage medium events based on state-transition matrix and event pseudo-generating information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2161

March 30, 2006



UYEN LE
PRIMARY EXAMINER